

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-35 were pending prior to the Office Action. In this Reply, claims 36-40 are added. Therefore, claims 1-40 are pending. Claims 1, 10, 16, 20 and 29 remain independent.

SCOPE NOT CHANGED

Claims 1-20 and 25-29 are amended merely to address informalities including addressing rejections under 35 U.S.C. § 112 and to put the claims in a form better suited for U.S. practice. Substantively, it is intended that the scopes of the claims are not narrowed.

ALLOWABLE SUBJECT MATTER

Applicants appreciate the Examiner's indication that claims 3-5, 21-24 and 30-32 include allowable subject matter. *See Office Action, item 9.* Applicants also appreciate the Examiner's indication that claims 12 and 18 also include allowable subject matter. *See Office Action, item 10.*

§101 REJECTION

Claims 10-19 stand rejected under 35 U.S.C. § 101 for allegedly being directed to a non-statutory subject matter. Independent claims 10 and 16 are amended to recite “computer-readable medium” and to recite “so that said image data is printed according to said print-order acceptor information”, i.e. a physical transformation outside the computer, as suggested by the Examiner. Accordingly, claims 10-19 are directed to statutory subject matter.

Applicants respectfully request that the rejection of claims 10-19 based on § 101 be withdrawn.

§112, 2ND PARAGRAPH REJECTION

Claims 6, 8, 19, 9 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. *See Office Action, items 3-5.* Applicants respectfully traverse.

Regarding claims 6, 8 and 19, these claims are amended to address the issues raised by the Examiner.

Regarding claims 9 and 15, these claims include the feature of “wherein said server-connection address information and said designated print-order acceptor information are renewable.” Applicants respectfully submit that the recited feature would be understood by one of ordinary skill. Therefore, claims

are definite and do particularly point out and distinctly claim the subject matter of the invention.

Applicants respectfully request that rejection of claims under 35 U.S.C. § 112, second paragraph be withdrawn.

§ 102 REJECTION – MCINTYRE

Claims 1-2, 7-11, 13-17, 19-20, 25 and 29 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by McIntyre et al. (US Patent 7,016,868). *See Office Action, item 7.* Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, McIntyre fails to teach or suggest each and every recited features of the claims. For example, independent claim 1 recites, in part “the computer-readable medium, storing ... a designated print-order acceptor information.” Contrary to the Examiner’s allegation, this feature is not taught or suggested by McIntyre. More specifically, the Examiner alleges that column 13, lines 41-52 discloses this feature. The relied upon portion of McIntyre merely discloses that an ID of an image retaining device - such as a film cartridge - can be provided on an image storage device 24, such as a CD. The
DRA/HNS/vd

ID of the image retaining device can be registered. The Examiner alleges that the ID reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order. Applicants respectfully disagree.

As demonstrated above, the ID is merely an identification of an image retaining device such as a film cartridge¹⁴. In Figure 1 of McIntyre, the roll of film 14 (also referred to as a film cartridge 14) includes a unique cartridge ID 17. In other words, the ID as disclosed in McIntyre only identifies the film cartridge. It cannot be used to identify any type of a print-order acceptor information that receives a print order. This is sufficient to distinguish claim 1 from McIntyre.

But in addition, claim 1 also recites, in part “said terminal unit is connected to said order receiving server ... so as to transmit said designated print-order acceptor information and at least a part of said digital image data at the same time to said order receiving server ... wherein said order receiving server outputs a print command data.” The Examiner alleges that column 6, lines 25-36, column 13, lines 41-52 and column 8, lines 44-49 of McIntyre discloses this feature.

However, the relied upon merely indicates that a user may register an image retaining device to a network photo service provider. There is no indication that both the image data and the print order request is transmitted

from the computer 30 to the network photo service provider 34 simultaneously. On the contrary, McIntyre indicates that the images are actually uploaded and stored at the network photo service provider 34 when an image retaining device 12 is registered. *See column 6, lines 32-37.* In other words, the images recorded on the image retaining device 12 are stored on the network photo service provider, and services to access the images stored on the network photo service provider may be requested. Thus, there is no need to transmit image data along with the print-order acceptor information.

This is further exemplified in Figure 3D of McIntyre which illustrates a good/service order confirmation display screen 39. The display screen 39 clearly indicates that the images associated with the film cartridge identified by ID are selectable from the server for printing and finishing processes.

It is clear that the feature of the terminal unit transmitting the designated print-order acceptor information and at least a part of the digital image data at the same time to the order receiving server as recited in claim 1 is not taught or suggested in McIntyre. It naturally follows that McIntyre also cannot teach or suggest the feature of "said order receiving server output said print command data based on the received digital image data, and a command data." For at least the above stated reasons, independent claim 1 is distinguishable over McIntyre.

Independent claim 10 recites, in part “a computer-readable medium ... for causing said terminal unit to connect to said order receiving server through said network when the computer-readable medium is mounted to said terminal unit and to transmit said image data and said designated print-order acceptor information at the same time to said order receiving server.” It is demonstrated above that McIntyre cannot teach or suggest this feature. Accordingly, claim 10 is distinguishable over McIntyre.

Independent claim 16 recites, in part “causing a terminal unit to connect to said print order receiving server through said network when the computer-readable medium is mounted to said terminal unit and to transmit said digital image data and said designated print-order acceptor information at the same time to said print order receiving server.” It is demonstrated above that McIntyre cannot teach or suggest this feature. Accordingly, claim 16 is distinguishable over McIntyre.

Independent claim 20 recites, in part “the terminal is configured to transmit print request data, the requested service shop data, and the image data at the same time to the selected print service receiving server” and “the selected print service receiving server is configured to transmit reception data to a requested service shop ... to fulfill a print order corresponding to the print request data and the image data.” It is demonstrated above that McIntyre

cannot teach or suggest these features. Accordingly, claim 20 is distinguishable over McIntyre.

Independent claim 29 recites, in part “transmitting reception data to a requested service shop to fulfill a print order corresponding to the print request data and the image data received from the terminal” and “wherein ... the service shop data and the image data are transmitted at the same time in the print request by the terminal.” It is demonstrated above that McIntyre cannot teach or suggest these features. Accordingly, claim 29 is distinguishable over McIntyre.

Claims 2, 7-9, 11, 13-15, 17, 19 and 25 depend from independent claims 1, 10, 16 and 20 directly or indirectly. Accordingly, these dependent claims are also distinguishable over McIntyre.

Applicants respectfully request that rejection of claims 1-2, 7-11, 13-17, 19-20, 25 and 29 based on McIntyre be withdrawn.

§ 103 REJECTION – MCINTYRE, HURTADO

Claims 26-28 and 33-35 stand rejected under 35 U.S.C. § 103(a) allegedly being unpatentable over McIntyre in view of Hurtado et al. (US Patent 6, 611, 812). *See Office Action, item 8.* Applicants respectfully traverse.

Claims 26-28 and 33-35 depend from independent claims 20 and 29 directly or indirectly, and it is demonstrated above that claims 20 and 29 are
DRA/HNS/vd

distinguishable over McIntyre. Hurtado is not relied upon to correct for at least the above noted deficiencies of McIntyre. Therefore, claims 20 and 29 are distinguishable over the combination of McIntyre and Hurtado. Accordingly, claims 26-28 and 33-35 are also distinguishable over the combination of McIntyre and Hurtado for at least due to their dependencies from claims 20 and 29.

Applicants respectfully request that rejection of claims based on McIntyre and Hurtado be withdrawn.

NEW CLAIMS

In addition to claims 36-40 are also added in this Reply. No new matter is presented. All new claims are distinguishable over the cited references, individually or in any combination, for at least due to their dependencies from independent claims. Applicants respectfully request that the new claims be allowed.

CONCLUSION

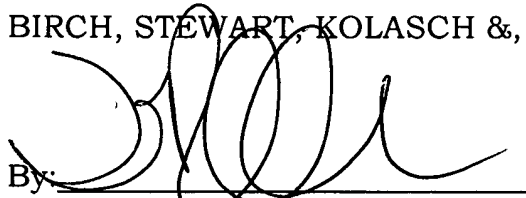
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. DRA/HNS/vd

No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

A handwritten signature in black ink, appearing to read 'D. Anderson', is written over a horizontal line.

By: _____
D. Richard Anderson
Reg. No. 40,439

HNS
DRA/HNS/vd
0649-0786P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

DRA/HNS/vd